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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/833,838 04/10/97 GAYNOR

B 96700/451

EXAMINER

HM12/0207

AMSTER ROTHSTEIN & EBENSTEIN
90 PARK AVENUE
NEW YORK NY 10016

EWOLDT, G

ART UNIT

PAPER NUMBER

1644

DATE MAILED:

02/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/833,838

Applicant(s)
Gaynor et al.

Examiner
Gerald Ewoldt

Group Art Unit
1644



☒ Responsive to communication(s) filed on Dec 20, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 54-74 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 54 and 63-74 is/are rejected.

☒ Claim(s) 55-62 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

CRP Error Report

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. Applicant has canceled all pending claims and submitted new claims 54-74. The newly-submitted claims read on the elected Invention and are being acted upon.
2. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. See the attached CRF Problem Report for specific details.
3. In view of Applicant's amendment and response, filed 12/20/00, only the following rejections remain.
4. The instant claims may not have the benefit under 35 U.S.C. § 120 of the parent filing date, 9/20/95. Subject matter claimed in the instant application is not supported in the parent application, Serial Number 08/531,832. Specifically, the parent application does not disclose "a method for treating or preventing glomerulonephritis" (Claims 54-74).

The filing date of the instant claims is deemed to be the filing date of the instant application, i.e. 4/10/97.

Applicant has not argued the denial of the benefit of priority.

5. The following are New Grounds of Rejection necessitated by Applicant's amendment, filed 12/20/00.
6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
A person shall be entitled to a patent unless --
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 54 and 63-74 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Gaynor et al. (March, 1997), for the reasons of record set forth in Paper No.8, mailed 6/20/00.

8. Claims 54, 63-66, and 71-74 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Spatz et al. (January, 1997), for the reasons of record set forth in Paper No.8, mailed 6/20/00.

Applicant's arguments, filed 12/4/00, have been fully considered but have not been found convincing. Applicant argues that the references are not prior art because they are the Inventor's own publications. While the authorship of the references includes the Inventors, it is not identical. Thus, the references are by "others" and the rejections are proper.

9. No claim is allowed.


10. Claims 55-62 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Gerald Ewoldt whose telephone number is (703) 308-9805. The examiner can normally be reached Monday through Thursday and alternate Fridays from 7:30 am to 5:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

G.R. Ewoldt, Ph.D.
Patent Examiner
Technology Center 1600
February 5, 2001


Patrick J. Nolan, Ph.D.
Primary Examiner
Technology Center 1600